

## REMARKS

I. Obviousness Rejection based on Krause, et al

Amended claims 1 to 16 were rejected under 35 U.S.C. 103 (a) as obvious over Krause, et al.

The main independent claim of Krause, et al, requires a decoration-free upper surface of the glass-ceramic or glass panel. The reasons for this requirement for the claimed invention of Krause, et al, are explained on page 4, lines 1 to 10, of the German language specification of Krause, et al. By keeping the upper surface of the glass-ceramic or glass panel free of a decorative layer the glass-ceramic or glass panel is easier to clean and smoother than it would be with a decorative layer. Furthermore the choice of possible colors is greater a decorative coating on the underside of the glass-ceramic or glass panel provides the color effect.

In contrast, claim 1 of the above-identified U.S. Patent application requires a decorative layer or coating on the upper surface of the glass ceramic or glass panel and a solid colored or plain IR permeable coating on the underside. The purpose of the present invention is to provide a cooking panel on which dirt is less conspicuous and to provide some protection from scratches and usage marks and the like for the upper surface of the panel (see lines 5 to 10 of page 4 of the above-identified U.S. Patent Application). Also by using a coating on the underside to provide a color a comparatively wider selection of background

colors is still possible, while providing a grid-like decorative coating on the top surface that reduces the conspicuousness of dirt and the like.

Thus Krause, et al, clearly teaches the exact opposite of the claimed invention of the above-identified U.S. Patent Application. Krause, et al, requires that the top surface of the panel is decoration-free in the main independent claim of that reference (true for all embodiments in Krause, et al), while the applicants require a decorative coating 7 on the top surface of the panel in all of their embodiments. There is no way to keep the top surface of the panel decoration-free and provide it with a decorative coating; these are exclusive alternatives.

It is well established that a prior art reference that teaches the opposite from a claimed invention cannot be used to reject the claimed invention under 35 U.S.C. 103 (a). For example, see M.P.E.P. 2145 X. D. Also many federal judicial opinions support this principle. For example, the Federal Circuit Court of Appeals has said:

"That the inventor achieved the claimed invention by doing what those skilled in the art suggested should not be done is a fact strongly probative of nonobviousness." in Kloster Speedsteel AB v. Crucible Inc., 230 U.S.P.Q. 81 (Fed. Cir. 1986), on rehearing, 231 U.S.P.Q. 160 (Fed. Cir. 1986).

Thus a reference, such as DE 200 05 461 U1, that teaches that the upper surface of a glass ceramic or glass panel should be decoration-free cannot be applied under 35 U.S.C. 103 (a) to reject a claimed glass-ceramic or glass panel with a decorative coating on its top surface.

The applicants' invention is especially unobvious because it provides a

maximum flexibility in attaining a desired color impression by a combination of features of a colored IR permeable coating on the underside and a grid-like decorative coating or layer on the top surface. As explained above the base color choices are greater when provided by a coating on the underside but the decorative coating can be patterned so that dirt and scratches are less conspicuous. Also the decorative coating provides some protection against scratches.

The Examiner in the corresponding European Patent Application has already found that a claim similar to the current claim 1 is allowable and a European Patent will issue for this invention. An Information Disclosure Statement together with a copy of the Office Action from the European Patent Office is being filed with this amendment.

The use of the decorative coating is not merely a matter of "design choice" because the decorative coating and its features are significant for the basic and novel characteristics of the claimed invention. There are many requirements for glass-ceramic or glass panels employed in the cooking arts, which can vary from country to country and for different applications. These panels should prevent observation of the interior of the cooking unit. They should provide a pleasing appearance but must stand up to usage involving scratching and cleaning and also be comparatively easy to clean. When provided with coatings the coatings must have a sufficient and lasting adherence to the basic glass or glass ceramic material.

Furthermore the decorative coating is not a matter of "design choice"

when the patent explicitly teaches that a decorative coating should not be provided on the top surface of the panel or that the top surface is "decoration-free".

Furthermore the Federal Circuit Court of Appeals has handed down a decision recently that clearly establishes that there must be a hint or suggestion of the modification of the disclosures in a prior art reference or references used to rejected a claimed invention under 35 U.S.C. 103 (a) and that the source of the hint or suggestion must be within the prior art reference or references. The Federal Circuit Court of Appeals has said:

A conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference" is an abuse of discretion. *In re Lee*, 61 USPQ 2<sup>nd</sup> at 1435 (Fed. Cir. 2002).

In the instant case the hint or suggestion of the applicants' claimed invention obviously cannot come from a prior art reference that teaches that the top surface of the glass or glass ceramic panel is decoration-free.

For the foregoing reasons withdrawal of the rejection of amended claims 1 to 16 under 35 U.S.C. 103 (a) over Krause, et al, is respectfully requested.

## II. Previous Rejections based on Prior Art

Acknowledgement of the withdrawal of the rejections of the claims under 35 U.S.C. 103 (a) in the Office Action dated September 5, 2003 is respectfully requested in view of the fact that the original claims 1 to 16 have not been

canceled but only amended to correct minor informalities. These rejections were based on Heidari, et al, Hikino, et al, Mitra, et al, Gabelmann, Welsch, McWilliams and Morsch, et al.

**III. Information Disclosure Statement**

The Information Disclosure Statement that was returned with the Office Action dated February 10, 2004 listed two Patent Abstracts of Japan references, but these references were not initialed indicating that they were not considered. However the Abstracts are in English and should be considered. Consequently return of another copy of this Information Disclosure Statement with the Patent Abstracts of Japan references initialed is respectfully requested, as well as listing of these Patent Abstracts on the first page of any patent that issues on the above-identified U.S. Patent Application.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

  
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